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In re Application of DÖRKEN et al
U.S. Application No.: 09/869,508
Int. Application No.: PCT/DE99/04099
Int. Filing Date: 27 December 1999
Priority Date: 29 December 1998
Attorney Docket No.: 101195-54

For: GENE TRANSFER VECTOR FOR THE
DIAGNOSIS AND THERAPY OF
MALIGN TUMORS

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to the papers filed 26 February 2002, which is being treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 27 December 1999, applicant filed international application PCT/DE99/04099, which claimed priority of an earlier Germany application filed 29 December 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 06 July 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 July 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 29 June 2001.

On 28 June 2001, applicant filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 29 August 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 26 February 2002, applicant filed the present petition along with a declaration executed by five of the six inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by five of the inventors each on his/her own behalf and on behalf of the nonsigning inventor Gerhard Wolff.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that inventor Gerhard Wolff refuses to sign the declaration. However, applicant has not demonstrated that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Wolff for signature. No evidence has been presented which suggests that Wolff ever received a complete copy of the application papers. Furthermore, applicant has not established that Wolff refuses to sign. No evidence regarding the circumstances of the alleged refusal has been provided.

With regard to item (3) above, applicant has not provided the requisite petition fee set forth in 37 CFR 1.17(i).

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

Because applicant has failed to satisfy items (2) and (3) above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the appropriate petition fee. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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